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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,917	06/29/2001	Hans-Joachim Fuchs	70231	9518
23872	7590	02/26/2007	EXAMINER	
MCGLEW & TUTTLE, PC P.O. BOX 9227 SCARBOROUGH STATION SCARBOROUGH, NY 10510-9227			SHAVER, RICKY D	
			ART UNIT	PAPER NUMBER
			2872	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	02/26/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/895,917	FUCHS ET AL.
	Examiner	Art Unit
	Ricky D. Shafer	2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 November 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 2-8 and 13-15 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,9-12 and 16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 June 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/10/2003</u>  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's election with traverse of invention IV (claims 9-12 and 16) in the reply filed on 11/30/2006 is acknowledged. The traversal is on the ground(s) that the restriction requirement is improper based on applicant's assertion that there are no subcombinations present in the application and that inventions I-VI are drawn to different combinations, each of which includes the specific (Bsp) details of the subcombination (claim 1); and that the inventions are closely related that there would be no undue burden to examine all of the claims of the non-elected inventions along with the elected invention.

This is not found persuasive because applicant's assertion that there is no subcombinations present in the current application is incorrect due to the prima facie presence of generic or linking independent claim 1 (defined as Bbr). It is noted that, in order for a dependent claim to properly depend from an independent claim, the dependent claim must further limit the subject matter of a previous claim (i.e., claim 1). Thus, any such dependent claim which depends directly from an independent claim, can be considered as either as a subcombination (Bsp) or a combination (ABbr) with respect to a generic or linking claim.

In present application, the examiner has properly considered inventions II, III and VI to be subcombinations (Bsp<sub>1</sub>, Bsp<sub>2</sub> and Bsp<sub>3</sub>, respectively) due to the fact that each of the above mentioned inventions only further limits an existing element (i.e., the first detent element having a spring characteristic; the first detent contour having a detent portion; and the mirror carrier or mirror foot being of a plastic material, respectively) with specific details (Bsp) of said element of which has been already recited and defined in independent claim 1 (Bbr).

In addition, the examiner has properly considered inventions I, IV and V to be combinations (ABbr, CBbr and DBbr, respectively) due to the fact that each of the above mentioned inventions adds at least one additional element (i.e., a sliding surface; a circular retaining element/sleeve; and a protruding lug, respectively) to the existing structure recited and defined in independent claim 1 (Bbr).

With respect to the issue that the claims are closely related, the restriction requirement set forth in the communication mailed on November 01, 2006 is based on the claimed structural differences between the various inventions and not on their similarities. Continued search and examination of claim(s) to a non-elected invention having substantially different structural limitations is a prima facie showing of burden. Applicant may overcome the requirement for restriction by presenting an allowable linking claim or by providing a clear admission on the record that the claim(s) drawn to a given non-elected invention is not patentably distinct from the elected invention.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 2-8 and 13-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11/30/2006.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 9-12 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification, as originally filed, fails to provide an enabling disclosure as to how to make and/or use the second detent contour (elements 15 or 16) of the mirror foot (1) in such a manner that the second detent contour is capable of being latched or unlatched to the mirror carrier (3).

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hashiguchi et al ('915).

To the extent the claim is enable by the original specification, Hashiguchi et al discloses an outside mirror for a motor vehicle comprising a mirror foot (14) fastenable to the vehicle; a mirror carrier (12) fastenable to the mirror foot so as to be capable of swiveling about a swiveling axis; a first detent element (18) associated with one of said mirror foot and said mirror carrier, said first detent element having a spring force (19) upon moving the first detent element from a rest position; a first detent contour (22a or 23) associated with the other of said mirror foot and the mirror carrier, the mirror carrier being fastenable to the mirror foot by virtue of a latching of said first detent element in the first detent contour (see Fig. 2); and a second detent contour (25) associated with the mirror foot, the position of the mirror carrier relative to the

mirror foot being securable at at least one defined swivel angle by virtue of a latching of the second detent contour to the mirror carrier (see Fig. 2), wherein the mirror carrier in the latched state of the first detent element is displaceable counter to pressure of the spring force at least far enough in the direction of the swiveling axis for the mirror carrier to be unlatchable from the second detent contour through swiveling of the mirror carrier. Note figures 1 and 2 along with the associated description thereof.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Gilbert et al ('640).

To the extent the claim is enable by the original specification, Gilbert et al discloses an outside mirror for a motor vehicle comprising a mirror foot (15) fastenable to the vehicle; a mirror carrier (16) fastenable to the mirror foot so as to be capable of swiveling about a swiveling axis; a first detent element (28) associated with one of said mirror foot and said mirror carrier, said first detent element having a spring force (20) upon moving the first detent element from a rest position; a first detent contour (25) associated with the other of said mirror foot and the mirror carrier, the mirror carrier being fastenable to the mirror foot by virtue of a latching of said first detent element in the first detent contour; and a second detent contour (23 or 24) associated with the mirror foot, the position of the mirror carrier relative to the mirror foot being securable at at least one defined swivel angle by virtue of a latching of the second detent contour to the mirror carrier, wherein the mirror carrier in the latched state of the first detent element is displaceable counter to pressure of the spring force at least far enough in the direction of the swiveling axis for the mirror carrier to be unlatchable from the second detent contour through swiveling of the mirror carrier. Note figures 1-3 along with the associated description thereof.

8. Claim 16 is objected to because of the following informalities:

In claim 16, line 5, the language “a deflection” should be changed to read --the deflection--. Appropriate correction is required.

9. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the structure (the two complementary detent elements on the mirror carrier) in which allows the second detent contour to be latched or unlatched to the mirror carrier must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky D. Shafer whose telephone number is (571) 272-2320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RDS

February 19, 2007

*Rainy D. Shaffer*  
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PATENT EXAMINER  
ART UNIT 2872